



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/352,951	07/14/99	OHE	M 503.33612CX1

020457 IM22/1210  
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EXAMINER
KELLY, C

ART UNIT	PAPER NUMBER
1721	3

DATE MAILED: 12/10/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
**09/352,951**

Applicant(s)  
**Ohe et al.**

Examiner  
**Kelly, C.H.**

Group Art Unit  
**1721**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-5 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/405,887.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892 ✓

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 ✓

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1721

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 16 and 25 of copending Application No. 08/405,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter is disclosed in the copending application. The liquid crystal composite instantly claimed is encompassed in the subject matter of the copending case..

Art Unit: 1721

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jubb et al., U.S. pat. No 5,698,134.

The Jubb reference discloses a liquid crystalline composite material having a compound of the formula included in instant claim 1. Jubb uses the liquid crystal composite in a display device. See claims 1, 14 and 16. The difference between the reference and the application is that the reference does not state the composite material is for use in a display device having electrode structure for generating an electric field having a components predominantly in parallel with one of the pair of substrates. The reference also does not state that the relationship between the elastic constant and dielectric anisotropy is  $< 9 \times 10^{-8}$  dyn or that the resistivity of the composite material is between  $1 \times 10^{13}$  and  $1 \times 10^9$  ohm.m. However, the same compounds would be expected to exhibit the same features. A resistivity in the claimed range would certainly be expected for the compounds of Jubb '134, given the compounds are of the same formula. As for the "use in liquid crystal layer in display device having said features. The use of the composite is given little weight as the claimed subject matter are drawn to a composition. Therefore, it would

Art Unit: 1721

have been obvious to one of ordinary skill in the art to make the claimed composite material because the reference teaches the same composite material.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan et al., U.S. apt. No. 5,498,365.

The Nolan reference discloses a liquid crystal composite having a liquid crystal layer having a compound of the formula of instant claim 1. See the claims. The composite is to be used in a liquid crystal display device. The difference between the reference and the application is that the reference does not give values for the resistivity of the composite material. The reference also does not state the details of the display having an electrode structure for generating an electric field having a components predominantly in parallel with one of said substrates. However, the use of the composite is given little weight in patentability determinations of composition claims. The resistivity of the material would be expected to be the same given that compounds of the formula are given by the reference are the same as the formulas claimed in the instant application claims. Therefore, it would have been obvious to one of ordinary skill in the art to make the claimed invention given the teachings of the reference.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kelly whose telephone number is (703) 308-0449. The examiner can normally be reached on Mondays through Thursdays.

Art Unit: 1721

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached on (703) 308-0756. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

C.H. Kelly  
Art Unit 1721  
C.H. Kelly